

## II. Interview Summary

Applicants thank Examiner Serrao for taking time on May 11, 2007, to participate in a telephone interview. The interview was conducted in light of the Office Action rejecting Claims 1-10 and 12-35. Participating in the May 11, 2007, interview were Examiner Ranodhi Serrao and applicants' representatives, Kevan Morgan and Sunah Lee. The discussion in the interview was directed to the distinction between Claim 1 and the cited art. Although no agreement was reached, Applicants believe that certain important clarifications were made. For example, in one aspect, applicants noted that Claim 1 recites a "second retail entity . . . receiving an image from the user using an imaging device," which is not disclosed, taught or suggested by the cited art.

## III. Claim Rejections Under 35 U.S.C. § 102(b)

### A. Independent Claim 1

Claim 1 is directed to a method for communicating information regarding a selected item to a user present at the location of a first retail entity. As recited in Claim 1, the method specifically requires that "while the user remains present at the location of the first retail entity, which first retail entity is different than a second retail entity," the second retail entity receives "an image from the user using an imaging device, wherein the image contains identifying data associated with the selected item as provided by the first retail entity." The method of Claim 1 further requires the second retail entity to extract "identifying information from the image" and use "the identifying data to obtain item information associated with the selected item" and from which "the selected item is available for purchase." These elements are not taught or suggested by Siegel, as the Office Action asserted.

### **Siegel Fails to Teach "Receiving an Image" . . . "Using Imaging Device"**

Applicants respectfully submit that Siegel fails to teach at least a second retail entity for "receiving an image from the user using an imaging device wherein the image contains

identifying data associated with the selected item as provided by the first retail entity," as recited in Claim 1. Instead, Siegel merely teaches an electronic retail network server that receives *scanned information*.

The Office Action relies on paragraph [0034] and paragraph [0037] of Siegel for allegedly teaching the second retail entity "receiving an image from the user using an imaging device, wherein the image contains identifying data associated with the selected item as provided by the first retail entity" as recited in claim 1. As discussed in the telephone interview, the cited paragraphs have nothing do with "receiving an image from the user" through "an imaging device." Rather, the cited paragraphs are merely directed to a device having *UPC scanning capabilities*, for example, a "customer electronic device" with attendant "*portable scanning and storage devices*" (paragraph [0034]) or "host devices" augmented with "*UPC scanning capabilities*" (paragraph [0037]) for scanning UPC symbol. Once a UPC symbol is scanned, "*the resulting machine readable data can be: (a) immediately made available to a server (such as an electronic retailing network) via the Internet, (b) stored to memory, making it available for later download, or (c) both made available to the server via the Internet and stored to memory.*" See Paragraph [0049]. Thus, the electronic retail network server in Siegel receives or downloads machine-readable scanned information (e.g. scanned UPC symbol) which is fundamentally different from "an image" received "from the user using an imaging device" as recited in Claim 1.

Moreover, receiving or downloading the scanned information is necessary in order for the electronic retail network server to operate as intended. For example, Siegel states:

As an example, a customer can *scan a UPC symbol* 100 of a stereo component at participating Store A using a scanning device 101 associated with an Internet-ready device 102. The device 102 can then contact an electronic retail network server 104 over the Internet and transmit *information concerning the UPC code* as well as information regarding the global position of the Internet-ready device 102. Using this information,

the electronic retail network server 104 can then supply information to the Internet-ready device 102 regarding pricing available at store A, as well as the nearby participating vendors (Store B, Store C, etc.). (Paragraph [0071])

In short, Siegel requires that, at a first retail entity (Store A), a consumer should scan a UPC symbol using a scanning device coupled to a consumer device so that the electronic retail network server can receive or download the scanned information (the information concerning the UPC code) which is machine readable information converted from the UPC symbol. Using the received scanned information, the electronic retail network server 104 can then supply information to the consumer device regarding pricing available at the first retail entity, as well as the nearby participating vendors.

Accordingly, Siegel fails to teach or suggest that the second retail entity receives "an image from the user using an imaging device wherein the image contains identifying data associated with the selected item as provided by the first retail entity" as recited in claim 1.

**Siegel Fails to Teach "Second Retail Entity"**

Further, applicants respectfully submit that claim 1 is patentably distinct from the cited art for at least the additional and independent reason that Siegel fails to teach a "second retail entity" that extracts "identifying data from the image" and uses "the identifying data to obtain item information associated with the selected item" and from which "the selected item is available for purchase," as recited in Claim 1.

As discussed above, the electronic retail network server uses the scanned UPC code information to supply pricing available at the nearby participating vendors (Store B, Store C, etc.). In other words, the electronic retail network server does not extract "identifying information from the image" but merely uses the machine-readable information as received.

Further, the selected item is not available for purchase, or other consumption, from the electronic retail network server. Instead, the selected item is available at the nearby participating

vendors. See Paragraph [0028]. Siegel does not teach or suggest that the nearby participating vendors extract identifying information from an image and use that information to obtain item information (e.g., pricing) associated with the selected item. Thus, neither the electronic retail network server nor the nearby participating vendors can be considered equivalent to a "second retail entity" that extracts "identifying data from the image" and uses "the identifying data to obtain item information associated with the selected item" and from which "the selected item is available for purchase," as recited in Claim 1. Siegel clearly fails to teach each and every element as set forth in independent Claim 1.

Under Section 102, "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Accordingly, for at least the reasons set forth above, applicants respectfully submit that Claim 1 is not anticipated by Siegel. Withdrawal of the rejection of Claim 1 is respectfully requested.

B. Dependent Claims 2 and 4-10

As discussed above, Siegel fails to teach each and every element of independent Claim 1. Dependent Claims 2 and 4-10 ultimately depend from independent Claim 1 and, thus, Claims 2 and 4-10 are likewise allowable over Siegel for at least the reasons discussed above in connection with Claim 1.

C. Independent Claim 12

Claims 12 and 15-28 were rejected under the same rationale as Claims 1-11, 13, 14, and 29-35 as having similar elements. (Office Action, page 7.)

In view of the above-described reasons with respect to Claim 1, applicants respectfully submit that Siegel fails to teach all of the elements of Claim 12. In particular, Siegel fails to teach a server comprising "a subsystem configured to receive an image from the user using the

imaging device, wherein the image contains identifying data associated with the selected item as provided by the first retail entity," as recited in Claim 12. Siegel also fails to teach "a server operated by a second retail entity" having "a subsystem configured to use the identifying data to obtain item information associated with the selected item available for purchase from the second retail entity." Accordingly, Claim 12 is not anticipated by Siegel. Withdrawal of the rejection of Claim 12 is requested.

D. Dependent Claims 13-21

Dependent Claims 13-21 ultimately depend from independent Claim 12. As discussed above, Siegel fails to teach each of the elements of independent Claim 12. Claims 13-21 also include a number of recitations not disclosed, taught, or suggested by Siegel, particularly when the recitations are considered in combination with the recitations of Claim 12 from which these claims depend. For the above-mentioned reasons, Claims 13-21 are likewise allowable. Withdrawal of the rejections under Section 102 is requested.

E. Independent Claim 22

Claim 22 recites elements similar to those of Claim 1. Accordingly, based on the above analysis of Claim 1, applicants respectfully submit that Siegel fails to teach all of the elements of Claim 22. In particular, Siegel fails to teach a "second retail entity" for operating the computer-executable component for "receiving an image from an imaging device being operated by a user present at a location of the first retail entity, said image containing identifying data associated with the selected item made available at the location of the first retail entity." Similar to Claim 1, Claim 22 recites "second retail entity" for operating the computer-executable component for "extracting the identifying data from the image" and "using the identifying data to obtain item information associated with the selected item, wherein the selected item is available for purchase from the second retail entity," which is not taught or suggested by Siegel. For at

least these reasons, the rejection of Claim 22 should be withdrawn. Accordingly, Claim 22 is not anticipated by Siegel and is allowable over the prior art.

F. Dependent Claims 23-29

Claims 23-29 are dependent on Claim 22 and, thus, are allowable for the reasons discussed above in connection with Claim 22. Claims 23-29 also include a number of recitations not disclosed, taught, or suggested by Siegel, particularly when the recitations are considered in combination with the recitations of Claim 22 from which these claims depend. For the above-mentioned reasons, Claims 23-29 are not anticipated by Siegel.

G. Independent Claim 30

The Office Action alleges that Siegel teaches the elements of: "communicating an image containing the identifying data; an input device for capturing an image of the selected item that contains identifying data associated with the selected item as provided by the first retail entity; a storage medium for storing said identifying data and program instructions for processing the image; a processing unit communicatively coupled to the input device, while the user remains at the location of the first retail entity," as recited in Claim 30. (Office Action, page 4.) The Office Action relies on paragraph [0034] for the teaching of such elements. (Office Action, page 4.) Applicants respectfully disagree.

Claim 30 includes the feature of "[a]n integrated portable apparatus for obtaining item information for a selected item available for purchase at a location of a first retail entity." The apparatus comprises, among other things, "a processing unit communicatively coupled to the input device, the output device, and the storage medium, for executing the program instructions that process the image by obtaining the item information for the selected item by communicating the image containing the identifying data to the second retail entity, wherein the selected item is available for purchase from the second retail entity." As aforementioned with respect to Claim 1, Siegel discloses that a consumer scans a UPC code using a scanning device coupled to a

consumer device so that the electronic retail network server can receive or download *information concerning the UPC code*, which is machine readable information converted from the UPC code. Using the received "*information concerning the UPC code*," the electronic retail network server 104 can then supply information to the consumer device regarding pricing available at the first retail entity, as well as the nearby participating vendors. These aspects of Siegel do not anticipate the apparatus claimed in Claim 30.

For at least the above reasons, as well as the reasons presented with respect to Claim 1, applicants submit that Claim 30 is patentable over the cited art.

H. Dependent Claims 31-35

Dependent Claims 31-35 depend from independent Claim 30. As discussed above, Siegel fails to teach each of the elements of independent Claim 30. Accordingly, Claims 31-35 are likewise patentable over the cited art.

IV. Claim Rejections Under 35 U.S.C. § 103(a)

As a preliminary matter, applicants note that Claim 3 depends from independent Claim 1, and Claim 33 depends from independent Claim 30. Accordingly, applicants respectfully submit that these claims are allowable for at least the reasons described above in regard to Claims 1 and 30. In addition, Claims 3 and 33 also include a number of recitations not disclosed, taught, or suggested by any of the cited and applied references, particularly when the recitations are considered in combination with the recitations of the claims from which these claims depend. For example, Claims 3 and 33 recite an element of "outputting the item information on an audio speaker of the imaging device when the item information is communicated from the second retail entity to the imaging device."

Under Section 103, a *prima facie* case of obviousness is established only if the cited references, alone or in combination, teach each of the limitations of the recited claims. *In re Bell*, 991 F.2d 781 (Fed. Cir. 1993). For at least the above reasons, the cited and applied

references, alone or in combination, fail to disclose or suggest each limitation recited in Claims 3 and 33. Accordingly, applicants respectfully submit that Claims 3 and 33 are patentable over the cited and applied prior art and request withdrawal of the Section 103 rejection.

#### CONCLUSION

In view of the foregoing remarks, applicants submit that all of the pending claims in the application are in condition for allowance. Reconsideration of the application and allowance of the claims is solicited. If the Examiner has any remaining questions or comments concerning this matter, the Examiner is invited to contact applicants' undersigned attorney at the number provided below.

Respectfully submitted,

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